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BOZICEVIC, FIELD & FRANCIS LLP			EXAMINER	
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The time period for reply, if any, is set in the attached communication.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte YING LUO, XIANG XU, CINDY LEO,
BETTY HUANG, and MARY SHEN

Appeal 2008-2048
Application 09/715,725
Technology Center 1600

Decided: May 21, 2008

Before DONALD E. ADAMS, LORA M. GREEN, and
FRANCISCO C. PRATS, *Administrative Patent Judges*.

ADAMS, *Administrative Patent Judge*.

ORDER REMANDING TO THE EXAMINER

This appeal under 35 U.S.C. § 134 involves claims 26, 27, 29, 30, and 32, the only claims pending in this application. We have jurisdiction under 35 U.S.C. § 6(b). However, on consideration of the record, we find that this case is not in condition for a decision on appeal, and thus remand it to the Examiner.

Evidence Relied Upon:

The Answer expressly states that “[n]o evidence is relied upon by the examiner in the rejection of the claims under appeal” (Ans. 4). However, notwithstanding this express statement to the contrary, the Examiner cites a number of references throughout the remainder of the Answer.

If the Examiner intends to rely on evidence to support the rejections of record this evidence must be clearly identified in the “Evidence Relied Upon” section of the Answer. However, if the express statement in the “Evidence Relied Upon” section of the Answer is correct, the Examiner should remove all reliance on the references cited in the Answer.

Further, assuming the Examiner does intend to rely on the evidence cited in the body of the Answer, the Examiner should insure that each evidentiary reference is present in the electronic file wrapper. In this regard, we note that Burgess and Shiseki do not appear to be of record in this Administrative Record. The PTO-1449 and PTO-892 forms separately identified in the electronic file wrapper do not list the Burgess or Shiseki references. In addition, it appears that a number of additional references cited by the Examiner (*e.g.*, Burgess), which are present in the electronic file wrapper, are not identified on these PTO-1449 and PTO-892 forms.

Accordingly, prior to taking any further action on this record, the Examiner should insure that the Administrative Record is complete.

Luo et al., US 6,737,232 B1, issued May 18, 2004:

According to Office records, the instant application is a continuation of Application No. 09/442,013, filed November 17, 1999. On May 18, 2004, Application No. 09/442,013 issued to Luo et al. as US Patent No.

6,737,232 B1. As a continuation the instant application would be expected to have the same disclosure as Luo. For clarity, we reproduce claims 7 and 11 of Luo and claim 29 on appeal below:

Luo:

7. A method of screening for a bioactive agent capable of modulating apoptosis in a mammalian cell, comprising:

a) contacting a candidate bioactive agent with a mammalian cell expressing a recombinant nucleic acid encoding an ING2 protein; and

b) measuring apoptosis in said mammalian cell;

wherein said encoded ING2 protein comprises an amino acid sequence selected from the group consisting the amino acid sequences set forth in SEQ ID Nos: 2, 4, 6, 8, and 10, wherein said ING2 protein will bind to an IAP in the absence of said candidate bioactive agent, and wherein a change in the inhibition of apoptosis indicates that said bioactive agent is capable of modulating apoptosis in a mammalian cell comprising an ING2 protein.

11. The method according to claim 7, wherein said ING2 protein comprises the amino acid sequence set forth in SEQ ID NO: 8.

Appealed claim 29:

29. A recombinant ING2 protein, consisting essentially of the contiguous amino acid sequence set forth SEQ ID NO: 8.

Notwithstanding the fact that, as a continuation, the disclosure in the instant Specification is expected to be the same as that in Luo, the Examiner asserts that “Examiner reviews the contemplated uses for the claimed SEQ ID NO:8 suggested by the specification and clearly provides reasons why

one would not know how to use SEQ ID NO:8 for the uses contemplated in the specification” (Ans. 4 (emphasis added)).

It would appear that the Examiner’s assertion on this record is in conflict with Luo, which claims a method of screening for a bioactive agent capable of modulating apoptosis in a mammalian cell, comprising: a) contacting a candidate bioactive agent with a mammalian cell expressing a recombinant nucleic acid encoding an ING2 protein; and b) measuring apoptosis in said mammalian cell; wherein said encoded ING2 protein comprises, *inter alia*, an amino acid sequence set forth in SEQ ID NO: 8.

Accordingly, prior to any further action on this record, we encourage the Examiner to take a step back and consider this administrative record together with Luo and any other available prior art to determine if the Examiner’s position on this record is in conflict with Luo.

If, after further consideration, the Examiner remains of the opinion that a rejection should be made, the Examiner should clearly articulate the basis for such a rejection insuring that any evidence relied upon in support of such a rejection is present in the electronic file wrapper.

CONCLUSION

In summary, we remand the application to the Examiner for further consideration and action consistent with the direction provided above.

REMANDED

clj

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